

### ***DETAILED ACTION***

**Claims 1-12, 17, 19, and 22-24** have been canceled. Therefore, **claims 13 -16, 18, 20 and 21** are currently pending in this application. **Claim 21** is withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference, which anticipates one group, would not render obvious the other.

### **Response to Remarks/Arguments**

Applicants' remarks and arguments filed on **January 21, 2010** has been fully considered and entered in the file. In regards to the objections of claims **13-16, 18 and 20**, the grounds of objections are moot in view of Applicants amendment and argument was found persuasive and therefore, the examination was extended to the full scope of currently amended claims.

### **Previous Rejection**

#### **103 Rejection**

Claims **13-16, 18 and 20** are rejected as being unpatentable over German Publication No. DE 10136065 to Elbe et al with a publication date of 02/06/2003 also see corresponding U.S. Patent Application No. US 20040204470. Applicants argue that in the currently claimed compounds R4 represents an alky, alkoxyalkyl, haloalkyl or

Art Unit: 1626

diketo substituent and therefore is not suggested by the prior art. Applicant's argument was fully considered but was not found to be persuasive for the same reasons presented in the previous office action and summarized below.

The difference between the claimed compounds and the prior art is that the instant claims **R<sup>4</sup>** and **R<sup>48</sup>** represent alkyl substituents in as opposed to hydrogen of the prior art. Applicants have not presented a showing of unexpected results owing to the presence of an alkyl group in the amide bridging group. MPEP 2144.08.II.A.4(c) states, "...consider teachings of a preferred species within the genus. If such a species is structurally similar to that claimed, its disclosure may motivate one of ordinary skill in the art to choose the claimed species or subgenus from the genus, based on the reasonable expectation that structurally similar species usually have similar properties."

It is sufficient if a reference compound is so closely related to claimed compound that a chemist would find the difference an obvious variation; thus, claims are refused where the difference is primarily the one which exists between a secondary and a tertiary amine. *Ex parte Bluestone*, 135 USPQ 199 (1961).

One of ordinary skill would be motivated, from the exemplified embodiments in the prior art disclosure, to make the modification required to arrive at the instant invention with reasonable expectation of success for obtaining an additional compound for the same utility. The motivation would be to make additional compounds for the same quoted purpose.

Therefore, this rejection is **maintained**.

**Double Patenting**

In regards to **obviousness-type double patenting rejection** of claims **13-17 and 20 over** claims **22-35, 37 and 46** of co-pending **U.S. Patent Application No. US 20040204470**, Applicants argument was not found persuasive **for the same reasons discussed above in the 103, rejection.**

Therefore, this rejection is **maintained.**

**Conclusion**

No claims are in condition for allowance. **THIS ACTION IS MADE FINAL.**  
Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

**Telephone Inquiry**

Art Unit: 1626

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamal A Saeed whose telephone number is (571) 272-0705. The examiner can normally be reached on M-T 7:00 AM- 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

Communication via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise requires a signature, may be used by applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or public PAIR only. For more information about the pair system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

/Kamal A Saeed/

Primary Examiner, Art Unit 1626

Application/Control Number: 10/576,050  
Art Unit: 1626

Page 6